

REMARKS

The Application has been carefully reviewed in light of the Office Action dated January 2, 2003 and the Advisory Action dated July 3, 2003. Claims 1 to 18 are in the application, of which Claims 1 and 10 are independent. Reconsideration and continued examination are respectfully requested.

In the Office Action, Claims 1 to 9 were rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,300,158 (Simberger) in view of U.S. Patent No. 6,262,558 (Weinberg). In response, Applicants submitted an Amendment with remarks responding to the Office Action on June 24, 2003. Shortly thereafter, on July 3, 2003 an Advisory Action was mailed indicating that the arguments presented in the June 24, 2003 Amendment were found unpersuasive.

According to Claim 1, the present invention relates to a solar battery device, having a solar battery, a power converter, an input connector, an output connector, a detector and a power converter controller. The power converter is structured to convert electric power output from the solar battery. Electric power from outside the device can be input through the input connector, structured for that very purpose. The output connector is structured to collect the electric power input by said input connector and the electric power output by said power converter, and output the collected electric power to outside said device. The current value of an electric current output to the output connector can be detected by the detector, which is structured to do so. As mentioned above, the present invention also includes a power converter controller, which is structured to control output of said power converter when the current value detected by said detector exceeds a

threshold value which is predetermined based on a maximum rated current value of said output connector or a current path of the output connector.

Because the present invention includes the feature of a controller that is structured to control the output of the power converter when the current value detected by the detector exceeds a threshold value which is predetermined based on a maximum rated current value of the output connector or a current path of the output connector, the present invention is advantageous over conventional systems because it prevents the overloading of the current paths leading out of the device. The applied art is not seen to teach or suggest this feature of the present invention.

According to the Advisory Action, the combination of Simburger and Weingberg teach all of the structural elements recited in Claims 1 to 9. Applicants respectfully submit that the combination of Simburger and Weinberg does not teach all the structural elements of the rejected claims, and in particular does not teach at least the structural element of a controller structured to control output of a power converter when the current value detected by said detector exceeds a threshold value which is predetermined based on a maximum rated current value of said output connector or a current path of the output connector. An explanation of Applicants' position is set out below.

As acknowledged in the Office Action dated January 2, 2003, Simburger does not teach the controller of the present invention. According to the same Office Action, Weinberg discloses the controller of the present invention, presumably by Weinberg's discussion of a plurality of switches and a switch controller.

In equating Weinberg's switches with the controller of the present invention, the Office Action appears to discount the functional language which defines the controller of the present invention and dismisses the language as a recitation of intended use. However, the functional language is not seen to be a recitation of intended uses. Functional language defines an element by what it does rather than what it is and is perfectly permissible claim language that cannot be ignored. See In re Swinehart, 169 USPQ 226 (CCPA 1971), cited at MPEP § 2173.05(g). Accordingly, functional language should be given full weight in claim analysis.

Weinberg's switches are not seen to be structured to perform the functions of the controller of the present invention. In particular, Weinberg's switches are not structured to control a power converter. Consequently, the two controllers are structurally different and Weinberg does not teach or suggest the controller recited in the present invention. As set forth in MPEP § 2143, to establish a prima facie case of obviousness, the prior art must teach or suggest all of the claimed elements. If the applied art does not disclose the controller of the present invention, the burden for establishing obviousness is not met.

Whether or not Weinberg's switches are "capable of performing" functions recited in the claims is irrelevant if the reference does not describe or suggest its structure. See In re Mills, 16 USPQ2d 1430 (CA FC 1990), cited at MPEP § 2143.01. While Weinberg's switches might be capable of being modified to perform the functions of the controller of the present invention, which is not conceded, there is no suggestion in the art to modify Weinberg's switches to do so. The fact that the prior art could be modified does not make the modification obvious absent some suggestion of the desirability of the

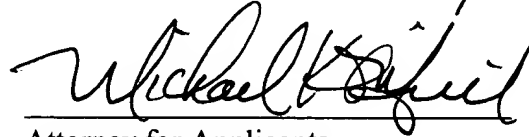
modification in the prior art. See In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984), cited at MPEP § 2143.01.

For its part, the Advisory Action relied on Ex parte Masham in explaining why it was permissible to ignore language it deemed “functional.” Applicant respectfully submit that reliance on Masham is improper in this case, since the facts and claim language in Masham are different from those here. In Masham, since the claims were directed to a mixing apparatus and not a mixing apparatus in use with developer, the fact that mixing means thereof was “completely submerged” in the developer was irrelevant, for the reason that the use fell outside the scope of what was claimed. In contrast, even insofar as some of the claim language here is deemed “functional,” the functional language is still part of the claimed device and therefore structurally distinguishes the device from the art.

For the foregoing reasons, the combination of Simburger and Weinberg are not seen to teach or suggest the features of the present invention and therefore would not have made the present invention obvious. Claim 1 and all the claims which depend therefrom are seen to be in condition for allowance.

Applicants' undersigned attorney may be reached in our Costa Mesa,
California office at (714) 540-8700. All correspondence should continue to be directed
to our below-listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael K. Scinto", written over a horizontal line.

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